

### Remarks

Claims 1 and 2 are pending in the application. Claims 1 and 2 have been amended herein. Non-elected Claims 3-6 have been canceled herein without prejudice. However, Applicants reserve the right to prosecute the subject matter of the canceled claims in related applications.

#### I. OBJECTIONS OF CLAIMS 1 AND 2

Claims 1 and 2 stand objected to because of informalities. Claims 1 and 2 have been amended to resolve the antecedent issues. Withdrawal of the objections is respectfully requested.

#### II. REJECTIONS OF CLAIMS 1 AND 2 BASED ON DOUBLE PATENTING

Claims 1 and 2 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 5,552,704 ("Mallory").

Independent claim 1 requires "(a) with the eddy current probe at a first separation from the sample, and with an AC voltage in the sensing coil, measuring a first voltage pair ...," and "(b) with the eddy current probe at the first separation from a reference material, and with the AC voltage in the sensing coil, measuring a second voltage pair ...". Claim 1 further requires, *inter alia*, "(c) calibrating the first signal based on the measured second signal."

In the Office Action, the Examiner appears to have ignored the differences between claims 1 and 2 of the present application, and claims 1 and 2 of the Mallory patent. However, it is respectfully submitted that any analysis employed in an obviousness-type double patenting rejection should parallel the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. MPEP 804, II. B. 1. Here, the Mallory patent's claims do not recite at least the above-identified features (b) and (c). Mere assertion that claims 1 and 2 of the prior patent "are broader than and encompasses the boundaries of the instant application" does not justify the obviousness rejections, just as 35 U.S.C. § 103 analysis should not.

In view of the foregoing, it is respectfully submitted that the obviousness-type double patenting rejections are legally impermissible. The Examiner's rejection of the dependent claim is respectfully traversed. However, to expedite prosecution, all of these claims will not be argued separately. Claim 2 depends directly from independent claim 1, and therefore, is respectfully submitted to be patentable over cited art for at least the reasons set forth above with respect to claim 1. Withdrawal of the rejections is respectfully requested.

**III. CONCLUSION**

Applicants believe that all pending claims are in condition for allowance, and respectfully request a Notice of Allowance at an early date. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 510-843-6200.

Respectfully submitted,  
BEYER WEAVER & THOMAS, LLP



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Limited Recognition under 37 CFR § 10.9(b)

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**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Expires: January 2, 2007**



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